



JUN 12 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

James E. Nilles  
Nilles & Nilles  
Firststar Center, Suite 2000  
777 Wisconsin Avenue  
Milwaukee, WI 53202

In re Application of	:	
JALALI et al.	:	
U.S. Application No. 09/581,272	:	DECISION ON PETITION
PCT No.: PCT/FR98/02636	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 07 December 1998	:	
Priority Date: 08 December 1997	:	
Atty. Docket No.: 136.147	:	
For: METHOD FOR CALCULATING THE FAST	:	
FOURIER TRANSFORM AND THE	:	
INVERSE FAST FOURIER TRANSFORM	:	

This is a decision on applicant's "Response to Notification of a Defective Oath or Declaration" which is being treated as a petition under 37 CFR 1.47(a) filed 16 February 2001 to accept the application without the signature of joint inventor, Al Jalali. The required petition fee of \$130.00 (37 CFR 1.17(i)) has been charged to Deposit Account No. 14-1080.

**BACKGROUND**

On 07 December 1998, applicant filed international application PCT/FR98/02636 which claimed a priority date of 08 December 1997 and which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 17 June 1999. A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 08 June 2000.

On 25 May 2000, applicant filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a translation of the international application; an unexecuted declaration; and a first preliminary amendment.

On 26 July 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b).

On 01 September 2000, applicant filed a second transmittal letter which included a declaration executed by two of the three inventors.

On 12 January 2001, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) and a NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (Form PCT/DO/EO/917) indicating that the declaration was

not in compliance with 37 CFR 1.66 or 1.68, and that a new oath or declaration in compliance with 37 CFR 1.497 along with a surcharge for providing the oath or declaration later than 20 months from the priority date were required.

On 16 February 2001, applicant filed a "Response to Notification of a Defective Oath or Declaration" which states "they (Cabinet Ballot-Schmit) are unable to obtain the signature of the first named inventor, Ali Jalali..." and therefore, this response has been treated as a Petition under 37 CFR 1.47(a).

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1) and (4) have been satisfied.

As to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

A review of the present petition and the accompanying papers reveal that applicant has not satisfied the item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Ali Jalali. Petitioner states that "[a] registered letter enclosing a Declaration and an Assignment (copies attached) was sent to

Mr. Jalai on September 28, 2000, but no response was received from Mr. Jalia." The petition fails to state what application papers were sent to the missing inventor. Was a complete application (specification, claims, and drawings) mailed to the missing inventor? Additionally, petitioner has provided copies of letters to Mr. Jalia, however, these letters have not been translated into English. Furthermore, it does not appear that the petitioner has first hand knowledge of all the facts.

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Mr. Jalali and when such papers were sent and that Mr. Jalali has subsequently refused to execute the application. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

Concerning Item (3), a statement of the last known address of the missing inventor has not been submitted.

Item (4) has been satisfied by the declaration filed 01 September 2000.

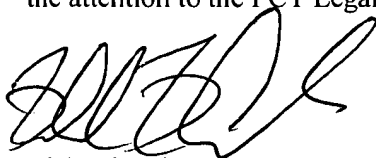
For the reasons stated above, it would not be appropriate to accept the application without the signature of Mr. Al Jalali under 37 CFR 1.47(a) at this time.

### CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



Richard Cole  
PCT Legal Examiner  
PCT Legal Office



Anthony Smith  
Petitions Attorney  
PCT Legal Office  
Tel.: 703-308-6314  
Facsimile: 703-308-6459